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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,366	02/17/2004	Alex Simmons	60001.0311US11/MS302493.1	1853

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EXAMINER

DESIRE, GREGORY M

ART UNIT	PAPER NUMBER
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2624

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11/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/780,366	Applicant(s) SIMMONS ET AL.	
	Examiner Gregory M. Desire	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14, 16-23, 29 and 31-44 is/are rejected.
- 7) ☒ Claim(s) 8-13, 15, 24-28 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/11/04, 7/25/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> |

Continuation of Attachment(s) 6). Other: 9/8/05, 10/20/05, 12/12/05, 2/9/06, 2/10/06, 3/17/06, 4/21/06, 5/22/06 & 10/10/06.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5, 7, 14, 16, 17, 18, 21, 23, 31, 32-34, 35, 37-40, 41, 42, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Capps et al (5,671,438).

Regarding claims 1, 17, 18, 32-34, 40 and 44 Capps,

Creating an outline object (col. 6 lines 53-55, examiner interprets bounding box as outline object that is created) having at least one line for receiving inputs of electronic ink (note col. 6 lines 57-58 lines 11-14 shows at least one line receive electronic ink), and encompassing at least one of the inactive writing guide and the active writing guide (note col. 6 lines 61-62, text entered on the screen with stylus, examiner interprets as active writing guide); and

In response to at least one line within the outline object being currently active to receive inputs of the electronic ink, displaying the active writing guide around the at least one line thereby indicating a location of a current active context (note fig. 3a, shows as display of the active writing guide showing line location of a current active context).

Regarding claims 3, 21 and 35,

At least one of distinguishing display of the outline object from any region not occupied by the outline object (note fig. 3a, L1 and L2 is display of outline object from any region) and in response to receiving more electronic ink within the at least one line, expanding the active writing guide by the outline object on the display (fig. 3a L1 and L2 can be expanded to PG#1).

Regarding claims 5 and 23,

Receiving inputs of electronic ink on a different line within the outline object other than the at least one line (note fig. 3a L3).

In response to receiving inputs on the different line, moving the active writing guide from around the at least one line to be displayed around the different line (note fig. 3a lines L1, L2, L3 and L4 are displayed and are different lines).

Regarding claims 7, 37 and 41,

In response to the different line beginning a new paragraph, expanding the outline object to include at least one empty line beyond lines containing electronic ink (fig. 3a L1 and L2 can be expanded to PG#1).

Regarding claims 14, 38-38 and 43,

Transitioning from a pen mode for receiving electronic ink to a text mode for receiving text characters (note fig. 2, block 62, and col. 5 line 45-48, status button you can change modes to text); and

In response to transitioning from a pen mode to text mode, displaying an insertion point of the text mode at the end of any line around which the active writing guide was last displayed prior to transitioning (note col. 5 lines 5-14 guideline aiding user enter text or graphics in the system).

Regarding claims 16 and 31,

A longest line of electronic ink displayed with the outline object (note fig. 3a L1)

An initial minimum width (fig. 3a, W1 word width is a minimal width)

Another object outside the outline preventing current maximum width from expanding (note fig. 3a Pg#1, maximum width does not expand based on PG#3)

Regarding claim 42,

In response to receiving input of an ink stroke in any region not occupied by the drawing guide, creating a new drawing guide (note fig. 2, block 68).

Claim Rejections - 35 USC § 103

3. Claims 2 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capps et al (5,671,438). Capps discloses substantially the claimed invention as set forth in the discussion above for claim 1, see fig. 3a)

Capps does not disclose expressly brackets defining a writing area. Applicant does not disclose that brackets defining a writing area provides an advantage, is used for a particular purpose or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the bounding box upper left corner or lower right corner, starting or ending position, respectively because both starting and ending corners perform the same function of providing boundaries for ink objects. Therefore, it would have been obvious to combine to one of ordinary skill in this art to modify Capps with to obtain the invention specified in claims 2 and 20.

4. Claims 4, 6, 22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capps et al (5,671,438) in view of Beernink (5,682,439).

Capps discloses input of line in a bounding area. Capps does not clearly disclose displaying outline object as a shaded region. Beernink discloses displaying outline object as a shaded region (fig. 11, 164). Capps and Beernink are combinable because they are from the same assignee. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include displaying a shaded region in the system of Capps as evidenced by Beernink. The suggestion/motivation for doing so would have been correcting an ink object (note col. 2 lines 50-55). Therefore, it would have been obvious to combine Capps with Beernink to obtain the invention as specified in claims 4, 22 and 36.

Regarding claim 6 Capps discloses,

Wherein displaying the outline object includes displaying at least one empty line for receiving electronic ink (note fig. 4, 44, shows empty line, Capps).

Allowable Subject Matter

5. Claims 8-13, 15, 24-28 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter for claims 8 and 24. The distinguishing feature is extension on the end of the any line within the outline object, wherein when inputs of electronic ink are received into the extension. Claims 9-13 and 25-28 depend on claims 8 and 24, respectively. Therefore are also objected.

Regarding claims 15 and 30, distinguishing feature is command applied to insertion point are also applied to electronic ink within the active writing guide without selecting the electronic ink within the active writing guide. This feature in combination with other feature is not taught in the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory M. Desire whose telephone number is (571) 272-7449. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

G.D.
November 7, 2007

GREGORY DESIRE
PRIMARY EXAMINER

